REMARKS

Claims 1, 3-7, 9-11, 13-16 and 19-23 are pending in the application.

Claims 1, 3-7, 9-11, 13-16 and 19-23 have been rejected.

Claims 1, 11, 16 and 21-23 have been amended, as set forth herein.

I. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 3-4, 7, 10-11, 16 and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over White (US Patent No. 6,069,890) in view of White (US Patent No. 6,021,126). Claims 5-6, 9, 13-15 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over White (US Patent No. 6,069,890) in view of White (US Patent No. 6,021,126) in further view of Chu (US Patent Application Publication No. 2005/0068942). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

With respect to the rejection of independent Claims 1 and 21, the Office Action asserts White '890 discloses virtually all of the recited elements, except for a call associated with a ported number. While the Office Action correctly notes that White '890 does fail to teach a call associated with a ported number, White '890 fails to teach all of the recited elements in combination and as arranged as they are in Applicant's claims.

Notably, the Office Action points to various devices in Figure 2 (and accompanying text) as teaching all of the recited elements, except for terminating the call at a softswitch-compliant gateway. For this element, the Office Action points to Figure 4. However, as explicitly stated in White '890, the system illustrated in Figure 2 is different from the system illustrated by Figure 4. In fact, the system shown in Figure 2 illustrates one proposed system (as set forth in a related application) while the "instant invention" described in White '890 "provides an alternate system with advantages" over the system of Figure 2. White '890, Col. 4, line 58 through Col. 5, line 7. This alternative system is the system described in Figure 4.

Thus, the Office Action has impermissibly picked out elements from two different systems described in White '890 in order to come up with all the noted elements of Applicant's system as recited in Claims 1 and 21. This is apparent, since the Office Action equates White '890's internet modules (72, 74) coupled to the internet (packet network) as being equivalent to Applicant's softswitch. Once the Office's initial interpretation was made that there were no other elements that could be interpreted in Figure 2 as meeting Applicant's softswitch-compliant gateway element, the Office turned to a different system as shown in Figure 4 in order to show such element was present.[1] However, these are two separate systems, and there is no teaching or suggestion that elements within these two systems should be combined into a single system undisclosed by White '890.

Applicant has amended the independent claims to clarify Applicant's claimed method/system. In particular, Claims 1 and 21 recite "terminating the call at a softswitch-compliant gateway, the softswitch-compliant gateway providing an interface between the originating circuit switch and a packet network" and "forwarding the call to a softswitch within the packet network." Clearly, White '890 fails to disclose both a softswitch within a packet network and a softswitch-compliant gateway providing an interface between the circuit switch and the packet network.[2]

Moreover, with respect to independent Claims 1 and 21, within the system illustrated in Figure 2 of White '890, a caller dials a predesignated prefix *82 in order to initiate an Internet telephone call followed by the directory number of the called party. White '890, Col. 5, lines 51-63. A CCIS message is then sent to the local office connected to the destination to determine whether the destination call station is busy. White '890, Col. 6, lines 3-12. Also, within the system illustrated in Figure 4 of White '890, a caller similarly dials the predesignated prefix *82 (or other

[1] Likewise, the system in Figure 4 might arguably disclose a gateway or softswitch, assuming the Examiner's interpretation is correct, but it does not disclose both elements.

[2] White '126 is directed to initiating a search within the Internet (packet network) which is triggered by receipt of a ported number. White '126, Abstract. No softswitches within a packet network and no softswitch-compliant gateways, as described and claimed in the present application, appear to be disclosed, taught or suggested in a circuit-switched and packet network system.

unique identifier) in order to initiate an Internet telephone call followed by the directory number of the called party. The LEC 102 sends the dialed destination number to the external gateway router 102 which queries the internet address database 112 for an IP address. White '890, Col. 8, lines 21-65. Thus, no query is performed that returns a routing number (in response to, and associated with, the called dialed number) to the originating switch.

In addition, Applicant respectfully submits that White '890's internet modules 72, 74 are not softswitches, as that term is used and described in Applicant's specification and claims. Further, Applicant respectfully submits that White '890's gateway routers 104, 116 are not softswitch-compliant gateways, as that term is used and described.

Therefore, Applicant submits the 103 rejection based on the proposed White-White combination fails to render obvious Applicant's independent claims[3] because White '890 fails to disclose one or more elements upon which the Office Action relies upon as being disclosed by White '890.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 1, 3-7, 9-11, 13-16 and 19-23.[4]

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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[3] The Office Action relies on the same reasoning in its rejection of independent Claims 1 and 21 to reject the other independent Claims 11, 16, 22 and 23. Therefore, the same reasoning set forth by Applicant applies to the rejection of Claims 11, 16, 22 and 23.

[4] For these same reasons, the proposed combination of White-White-Chu fails to render obvious dependent Claims 5-6, 9, 13-15 and 19. Chu fails to cure the noted deficiencies in White.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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